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EXAMINER

WONG, STEVEN B

ART UNIT	PAPER NUMBER
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3711

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/479,985
Filing Date: January 10, 2000
Appellant(s): FEENEY ET AL.

Michelle Bugbee (Reg. #42,370)
For Appellant

EXAMINER'S ANSWER

MAILED
SEP 17 2002
GROUP 3700

This is in response to the appeal brief filed August 16, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because the appellant fails to argue why the groups are separately patentable. The appellant's brief merely points out the differences in what the claims cover which is not a suitable argument as to why the claims are separately patentable. Therefore, because the appellant fails to argue why the claims are separately patentable, claims 1-16 and 22 stand or fall together.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-16 and 22 are rejected under 35 U.S.C. 103(a). The rejections of these claims are set forth in prior Office Action, Paper No. 12 and cited by appellant in his arguments.

(11) Response to Argument

Regarding appellant's argument that the reference to Walker et al. is directed to a basketball having a synthetic cover whereas the instant invention is concerned with a basketball having a vulcanized urethane gum rubber, attention is directed to the "Manual for the Rubber Industry". The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation lies within the teachings of the "Manual for the Rubber Industry". The inventors of the basketball of Walker et al. were concerned with providing a cover that provided improved wear and rebound characteristics (note column 6, lines 23-31 of Walker et al.). The "Manual for the Rubber Industry" teaches advantages to their vulcanized urethane gum rubber which would be realized by one of ordinary skill in the art as being desirable for a game ball. Specifically, "Manual for the Rubber Industry" states that the gum rubber possesses "particularly good mechanical properties" and "wear resistance under many service conditions is better than that of other elastic materials". These advantages would clearly be recognized by one of ordinary skill in the art as being desirable for the outer cover of a game

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ball and thus, to form a game ball from the gum rubber taught by the "Manual for the Rubber Industry" would have been obvious.

As stated by appellant, Walker et al. is concerned with providing a basketball with a synthetic cover that feels like leather and has the characteristics of leather. Surely, one of ordinary skill in the art would modify the teachings of Walker et al. (to replace the synthetic cover with a cover of vulcanized urethane gum rubber) should he find a material which is advertised as having improved upon the very mechanical characteristics of which Walker et al. was concerned.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding appellant's statement that the examiner is using "selective blindness" in modifying the teachings of Walker et al., it appears in fact that appellant is guilty of using "selective blindness". The appellant continues to hinge his arguments solely on the fact that Walker et al. teaches a synthetic leather cover and not consider the reference and its teachings as a whole. Walker et al. make clear that their objective for the invention is to provide a cover for a basketball that provides superior rebound and wear characteristics and improved feel and handling properties. Surely, given the teachings of the "Manual for the Rubber Industry" where improved wear and mechanical characteristics are specifically touted and the suggestion by

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Walker et al. to provide a cover with the desirable rebound and wear characteristics, one of ordinary skill in the art would replace the synthetic cover with a cover formed from vulcanized gum rubber.

Regarding the appellant's statement that the cover of Walker et al. is not a polyurethane rubber cover but instead a synthetic cover produced using a polyurethane solution and polymeric fibers, attention is directed to column 5, lines 15-27 of Walker et al. which refer to a polyurethane layer. While the layer may include polymeric fibers, the relevance of this argument is not seen as the basis for rejection clearly states replacing the cover of Walker et al. with a material as taught by the "Manual for the Rubber Industry".

Regarding the combination of Molitor et al. in view of the "Manual for the Rubber Industry", the motivation to combine the references again lies within the teachings of the "Manual for the Rubber Industry". The advantages as stated by the "Manual for the Rubber Industry" and reiterated above would also be desirable with the game ball as taught by Molitor et al. Further, as noted by appellant, Molitor et al. states that the cover may be made from any material known at the time such as rubber, leather or any other well known material (column 2, lines 31-33). Thus, it would have been obvious to one of ordinary skill in the art to form the cover of the ball of Molitor et al. from a vulcanized urethane gum rubber in order to take advantage of that material's physical characteristics as noted by the "Manual for the Rubber Industry".

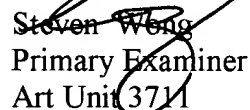
Regarding the appellant's statement that the examiner has failed to consider the Molitor et al. reference as a whole, the statement of Molitor et al. to form the cover from rubber, leather or any other well known material is a suggestion to one of ordinary skill in the art to provide the ball with a cover of a material dependent upon the manufacturer's concerns. Here, the "Manual

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for the Rubber Industry” provides a rubber having improved mechanical properties which would be desirable for a cover of a basketball. Thus, it would have been obvious to one of ordinary skill in the art to provide the basketball of Molitor et al. with a cover formed from a vulcanized urethane gum rubber as taught by the “Manual for the Rubber Industry” given the suggestion by Molitor et al. to provide a rubber cover and the teaching of the “Manual for the Rubber Industry” that vulcanized urethane gum rubber provides certain physical characteristics which would be desirable for a basketball.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Steven Wong
Primary Examiner
Art Unit 3711

SBW

September 11, 2002

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